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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/669,801 | 09/25/2003 | Masahiro Terada | FJ-2003-018-US | 8163 |
| 21254 7590 01/23/2007 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817 | | | EXAMINER NEGRON, WANDA M | |
| | | | ART UNIT 2622 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/23/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/669,801

Applicant(s)

TERADA, MASAHIRO

Examiner

Wanda M. Negrón

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because the meaning of lines 28-30 in page 3 of the specification is unclear. The sentence does not seem to address the reason for which an editor is needed to determine the transition effects to be used between motion picture segments. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

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4. **Claim 4 is rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter as follows. **Claim 4** defines “an image editing program” embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). That is, the scope of the presently claimed “image editing program” can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kellock et al. (US Pre-Grant Publication 2004/0027369 A1).**

7. Regarding **claim 1**, Kellock et al. disclose an image editing apparatus, i.e. an editing system (see Abstract), comprising a recording device, i.e. a disk or non-volatile

memory (see paragraph [0061]), which records a plurality of images, i.e. video segments (101), associated with image related information, i.e. video descriptors (111), including at least one of a shooting date and time, a shooting condition, a shooting place, and a user name (see paragraphs [0056] and [0062]); a video effect recording device, i.e. style information (106) which would be inherently stored in a memory device in order for the editing system to make use of it, which records image related information associated with a video effect during image switching, i.e. transition effects parameters and their input-dependent values (see paragraphs [0101] and [0102]); a comparison device, i.e. a constructor (121), which reads first image related information about a first image, e.g. a first video segment descriptor of low brightness (see paragraph [0106], lines 10-13), recorded in the recording device and second image related information about a second image, e.g. a second video segment descriptor of low brightness (see paragraph [0106], lines 10-13), recorded in the recording device, and compares the image related information about the first and second images, e.g. verifies that the low brightness shooting condition is satisfied by both segments (see paragraph [0106], lines 10-13); a video effect selection device, a constructor (121), which reads from the video effect recording device a video effect during image switching according to matching image related information, e.g. determining the use of slow dissolve transitions when the video segments to be edited satisfy a low brightness condition (see paragraph [0106], lines 10-13), when there is the matching image related information, e.g. a dark shooting condition, between the image related information about the first and second images as a result of the comparison; an image joining device, i.e.

a renderer (123), which reads the first and second images recorded in the recording device, and joins the images by applying the video effect during image switching read by the video effect selection device to a portion in which the images are to be joined in time, e.g. concatenates a first and a second video segment of low brightness with slow dissolve transitions (see paragraph [0106], lines 10-13); and an output device, i.e. an audio-visual monitor (see paragraph [0075], lines 7-9), which outputs the joined images, i.e. an output production (108).

8. **Claim 2** has limitations similar to those treated in the above rejection of claim 1, and those limitations are met by Kellock et al. as discussed above. In addition, **claim 2** recites the following limitations also anticipated by Kellock et al.: a recording medium loading unit which loads the recording device, i.e. an inherent means for importing embedded descriptors to the editing device (see paragraph [0062], lines 1-10), and the use of a range of image related information instead of matching image related information, e.g. the use of an indirect matching with derived descriptors (see paragraph [0171], lines 6-9, and paragraph [0172], lines 5-8) instead of identical type descriptors.

9. **Claim 3** has limitations similar to those treated in the above rejection of claim 1, and those limitations are met by Kellock et al. as discussed above. In addition, **claim 3** recites the following limitation also anticipated by Kellock et al.: the use of a range of image related information instead of matching image related information, e.g. the use of an indirect matching with derived descriptors (see paragraph [0171], lines 6-9, and paragraph [0172], lines 5-8) instead of identical type descriptors.

10. **Claim 4** is drawn to an image editing program for performing the operation process or steps corresponding to the apparatus claimed in claim 3, said apparatus also comprising an information processing device for controlling and synchronizing the operation of the recording device, the video effect recording device, the comparison device, the video effect selection device, the image joining device, and the output device. **Claim 4** corresponds to apparatus claim 3 and is rejected for the same reasons of anticipation as used above, since it would have been inherent that a processing unit would have been required in order to operate both, the editing apparatus claimed in claim 3, and the editing system disclosed by Kellock et al..

11. Method **claim 5** is drawn to the method of using the corresponding apparatus claimed in claim 3. Therefore, method **claim 5** corresponds to apparatus claim 3 and is rejected for the same reasons of anticipation as used above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Savoie (US 6,571,051 B2) discloses an image data editing system arranged to capture source image clips and conform them to produce an output image clip in response to edit decision lists.
- Moriwake et al. (US 7,055,100 B2) disclose an editing system for producing a resultant clip from a plurality of clips, and storing and managing information

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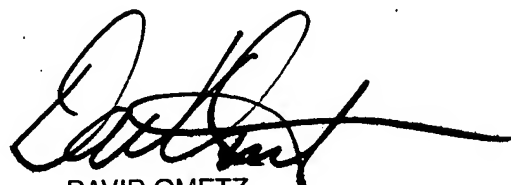
indicating relations between the clips in a database according to a hierarchical structure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wanda M. Negrón whose telephone number is (571) 270-1129. The examiner can normally be reached on Mon-Fri 6:30 am - 4:00 pm alternate Fri off.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Wanda M. Negrón
January 18, 2007



DAVID OMETZ
SUPERVISORY PATENT EXAMINER